

Applicant(s): RICHARD E. FORKEY AND RICHARD G. CYR AND ROBERT N. ROSS
Serial No.: 10/659,727
Filed: September 10, 2003

REMARKS

This application was examined with claims 1 through 25. Claims 10 through 25 are allowed. Claim 1 is amended. Claims 1 through 25 remain in the application.

Applicant requests reconsideration and reexamination of the above-identified application in view of the amendments made to the specification and claims. The following remarks state Applicant's bases for making this request and are organized according to the Examiner's Action by paragraph number.

Examiner's Action, Paragraphs 1 and 2

Applicant acknowledges the determination that the prosecution in this application was reopened properly and that the information disclosure statement has been considered.

Examiner's Action, Paragraphs 3 and 4

The Examiner rejects claims 1 through 9 under 35 U.S.C. §102 as anticipated by U.S. Patent No. 5,760,976 to DeLaMatyr et al. (the "DeLaMatyr patent") arguing that:

DeLaMatyr discloses, as in claims 1-9, an optical device extending along a geometric axis comprising: A) a final lens element (12) [characterized B) formed from an initial lens by centered, rotational symmetry about an optical axis, said final lens element having at least one sawn] planar face (see fig. 1 below, ref. 1) extending between image forming surfaces transverse to said geometric axis at each end of said final lens element, said [at least one sawn] planar face (see surfaces of ref. 1, fig. 1)

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being parallel to and spaced from the geometric axis, and a sheath (18) surrounding said lens element, Claim 1 also recites product by process limitation in which the lens structure is a sawn process. The determination of patentability is based upon the product itself in a product by process claim (see MPEP 2173.05(p)) and consequently, the sawn process is not considered.

Applicants respectfully traverse this rejection.

Claim 1 is presently amended to correct a minor typographic error.

Reconsideration of claims 1-9 in light of the foregoing amendment and the following remarks is requested.

Claim 1 recites: "An optical device extending along a geometric axis comprising: A) a final lens element formed from an initial lens element characterized by centered, rotational symmetry about an optical axis, said final lens element having at least one sawn planar face extending between image forming surfaces transverse to said geometric axis at each end of said final lens element, said at least one sawn planar face being parallel to and spaced from the geometric axis, and B) a sheath surrounding said lens element."

Thus, Claim 1 recites an optical device with "a final lens." The claim further limits the characteristics of the lens and the method of making the lens. In particular, the claim states that the lens, as an initial lens, has centered rotational symmetry about an optical axis. In the

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specification, at paragraph no. 0027, referring to Fig. 1,
Applicants describe a lens as follows:

"Although not shown, but as will be known to persons of ordinary skill in the art, the end surfaces of each lens element constitute image forming surfaces that are polished, generally spherical surfaces that produce an image of any object proximate the axis 21."

The DeLaMatyr patent does not show any lens. Rather, the DeLaMatyr patent discloses an apparatus for mounting an elongated optical member so that the member is minimally contacted and is permitted to thermally expand and contract. See Claim 1. The optic in DeLaMatyr is glass rod integrating optic. For example, DeLaMatyr states, "A polished glass rod is an effective integrating optic for a display system, and is inexpensive to fabricate." Col. 3, lines 40-41. "Furthermore, because the glass rod integrating optic relies on internal reflection to ensure efficient operation, and because permitting the glass integrating rod to be contacted with media other than air may defeat the internal reflection, contact between the mount and the glass integrating rod must be minimized." Col. 3, lines 59-64.

Moreover, the integrating optic of the DeLaMatyr patent does not include any image forming surfaces. Nor does the glass rod have centered rotational symmetry about an optical axis.

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"Anticipation is established only when a single prior art reference discloses, either explicitly, or under the principles of inherency, each and every element of a claimed invention." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Even though the identity of the words in the claim is not required, all of the elements of the invention must be arranged as required by the claim.

It is axiomatic that the words in the claim are given their broadest reasonable interpretation for examination. However, when the words in the claim name a structure with a term well known to those in the art, it is not proper to ignore the limitations inherent in that structure when examining the claim. Moreover, when the claim, by the words in the claim, further limits the structure, any construction of the claims that ignores those limits is improper. Claim 1 requires that the optical device include a lens, i.e. an optic that refracts light and forms an image of an object placed proximate the lens.

As the DeLaMatyr patent does not show or suggest a lens, nor any other structure with centered rotational symmetry about an optical axis, the DeLaMatyr patent does not show every

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element contained in Claim 1. Moreover, none of the art of record shows any lens or lens system having at least one planar surface parallel to any geometric axis.

Examiner's Action, Paragraphs 5 and 6

Applicants appreciate that the Examiner has allowed claims 10 through 25.

Examiner's Action, Paragraph 7

Applicants have reviewed the other prior art made of record. Applicants believe that the claims define an invention that is patentable over any of these references taken singly or in conjunction with each other or the DeLaMatyr patent.

Applicants submit that the claims are in condition for allowance because none of the cited references discloses the invention as set forth in any of the claims and because none of the references, taken singly or in combination, suggests the invention as set forth in any of the claims.

Respectfully Submitted,



GEORGE A. HERBSTER
Reg. No. 24,002
40 Beach Street
Manchester, MA 01944
(978) 526-8111